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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,098	09/18/2003	Anatoly Z. Rosenflanz	58961US002	7130

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EXAMINER

GROUP, KARL E

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/666,098

Applicant(s)

ROSENFLANZ ET AL.

Examiner

Karl E. Group

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 27-70, 72, 73 and 76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26, 71, 74 and 75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/11/04, 8/12/04, 11/18/05, 1/20/05, 6/16/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. Applicants are reminded to use the proper claim indicators. Any further amendments without the proper indicators will be considered non-compliant. For example claim 76 is drawn to non-elected inventions that are withdrawn from consideration.

***Information Disclosure Statement***

2. The previously cited information disclosure statements have been considered.

Conelly 3,560,780 (drawn to a vacuum tube), Woods (4,014,122) (drawn to a paperweight) and WO 03/001776 (drawn to a non-glass film) have been crossed off the IDS filed 2-13-06 because they are not considered to be relevant to the claimed invention.

***Claim Rejections - 35 USC § 102 and 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-14,18-21,23-26,71,74,75 are rejected under 35 U.S.C. 102(b) as anticipated by Elmer et al (3,754,978), for reasons of record.

Applicants' argument that the glaze taught by Elmer et al contains significantly more than 20 wt% SiO<sub>2</sub> is not persuasive in overcoming the rejection. The glaze taught by Elmer et al does not contain SiO<sub>2</sub>, see column 2, lines 17-25. There is no SiO<sub>2</sub> added to the glaze, the SiO<sub>2</sub> is the substrate the glaze is added to. Even if a reaction occurs, applicants have not supplied any tangible evidence that the SiO<sub>2</sub> would be present throughout the glaze in amounts greater than 20wt%. Furthermore, any

Art Unit: 1755

reaction would be expected to be at the interface of the substrate and the glaze not the entire glaze and would lead to small amounts of silica. There is no tangible evidence that the amount of  $\text{SiO}_2$  in the glaze is greater than 20wt%, particularly when the three components of the glaze form a glass. It is emphasized the mixture of  $\text{Al}_2\text{O}_3$ ,  $\text{ZrO}_2$  and  $\text{Ta}_2\text{O}_5$  forms a glass and does not require  $\text{SiO}_2$  to form a eutectic. The non-patent literature cited by applicants does not show the phase diagrams of a mixture of  $\text{Al}_2\text{O}_3$ ,  $\text{ZrO}_2$  and  $\text{Ta}_2\text{O}_5$  combined.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-26,71,74,75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3,6-23,69,73

and 74 of copending Application No. 10/616212. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons set forth.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No arguments have been presented in response to this rejection and is therefor considered proper.

7. Tachiwama (6,818,578) is cited as prior art of reference where examples 1 and 9 include 81.3 wt% and 81.1 wt% respectively, of a total of rare earth oxide (including yttria),  $ZrO_2$ ,  $Nb_2O_5$  and  $Al_2O_3$ , which falls within the scope of the instant claims.

8. The rejection of claim 9 under 35 USC 112, second paragraph is withdrawn. The 100% is considered to limit the claims to only the claimed constituents, thereby excluding the presence of any other components in any amounts, including impurities.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl E. Group whose telephone number is 571-272-1368. The examiner can normally be reached on M-F (6:30-4:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Karl E Group  
Primary Examiner  
Art Unit 1755

Keg  
2-27-06